



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,221	05/26/2000	Sung-Soo Lee	P56056	8252

8439 7590 08/27/2004

ROBERT E. BUSHNELL
1522 K STREET NW
SUITE 300
WASHINGTON, DC 20005-1202

EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,221

Applicant(s)

LEE, SUNG-SOO

Examiner

CHAN S PARK

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's response to the Office Action dated 3/10/04 was received on 6/3/04, and has been entered and made of record. Currently, **claims 1-17** are pending.

Response to Arguments

2. Applicant's arguments, see pages 2-21, filed 6/3/04, with respect to the rejections of claims 1-21 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Suzuki Japanese publication No. 03-274943, Konno et al. U.S. Patent No. 6,154,286 (hereinafter Konno), Ogura U.S. Patent No. 4,876,609 and Bloomfield U.S. Patent No. 6,693,729.

Claim Objections

3. Claim 13 is objected to because of the following informalities: Perhaps "a transmitting part" should be "the transmitting part" in line 5. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Konno et al.

4. With respect to claim 1, Suzuki teaches a method for controlling transmission of fax data according to a data output order of receiving part, the method comprising the steps of:

scanning and storing a document into data to be transmitted from a facsimile of a transmitting part to a facsimile of said receiving part;

dialing a predetermined telephone number of said receiving part when said document is completely scanned;

receiving said data output order by said transmitting part from said receiving part after the telephone number of said receiving part is dialed (receiving reply from a receiver side facsimile); and

transmitting said stored document data according to said received data output order (last six lines).

It is well known to one of ordinary skill in the facsimile art that any conventional facsimile machine has a scanner for scanning facsimile document, a memory for either

Art Unit: 2622

temporarily or permanently storing the scanned document and a dialing means for dialing a receiving facsimile for making a communication path.

Suzuki, however, does not teach expressly the method of requiring said data output order by said transmitting part.

Konno, on the other hand, teaches a method for controlling transmission of fax data, the method comprising the steps of:

scanning and storing a document into data to be transmitted from a facsimile of a transmitting part to a facsimile of said receiving part (col. 11, lines 49-51);

dialing a predetermined telephone number of said receiving part when said document is completely scanned (phase A in fig. 8);

requiring and receiving capabilities of the receiving part by the transmitting part (phase B in fig. 8); and

transmitting said stored document data according to the capabilities that the receiving part can receive (col. 11, lines 57-63).

Suzuki and Konno are analogous art because they are from the same field of endeavor that is the facsimile art.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the facsimile protocol method shown in fig. 8 of Konno into the output order arranging method of Suzuki.

The suggestion/motivation for doing so would have been to fully recognize the capabilities of the receiving part before the transmission of the facsimile data so that the transmitting part can make necessary changes to the facsimile data.

Therefore, it would have been obvious to combine Suzuki with Konno to obtain the invention as specified in claim 1.

5. With respect to claim 2, the combination of Suzuki and Konno teaches the method of claim 1 and Konno further teaches the method comprising the step of displaying operation procedures in a display (col. 10, lines 57-59). Thus, it would have been obvious to ordinary skill in the art at the time of the invention to implement the display panel of Konno into the facsimile of Suzuki. The motivation/suggestion for doing so would have been to inform the user with transmitting procedures when the transmitting output order (operation procedures) has been changed according to the reply received from the receiver side (last six lines of Suzuki).

6. With respect to claim 3, the combination of Suzuki and Konno teaches the method of claim 1 and Konno further teaches that when a printing part in the receiving facsimile system is in a face-up mode, the facsimile data stored in the memory must be read out descending order whereas when it is in a face-down mode, the data must be read out ascending order (col. 19, lines 20-42).

Moreover, Suzuki teaches the method of transmitting either the first page first or the last page first according to the reply from the receiver side.

Thus, at the time of the invention, it would have been obvious to one of ordinary skill in the art to send a command to indicate the output order based on the mode the printing part of the receiving side is in.

The motivation/suggestion for doing so would have been to eliminate a need for the rearrangement of the facsimile data at the receiving side.

Therefore, it would have been obvious to combine Suzuki with Konno to obtain the invention as specified in claim 3.

7. With respect to claim 4, the combination of Suzuki and Konno teaches the method of claim 1 and Konno further teaches the method with both of said transmitting part and said receiving part supporting a non-standard mode, said receiving part reporting said data output order to said transmitting part by sending a predetermined bit of data (fig. 8).

8. With respect to claim 5, Suzuki teaches said scanned document data being managed in a unit of a page and being stored in a memory of said transmitting part (last three lines).

9. With respect to claim 6, the combination of Suzuki and Konno teaches the method of claim 1 and Konno further teaches the method with said requiring of said capabilities being made during Phase B of a facsimile transmission, Phase B being a sequence of checking states of said transmitting part and a transmission line and controlling said transmitting part among a plurality of predetermined protocols used in transmission and reception of facsimile data (Phase B in fig. 8 and col. 11, lines 5-63).

10. With respect to claim 8, Suzuki teaches a method, comprising the steps of:

scanning a document into data to be transmitted from a facsimile of a receiving part;

storing said data of said document in a memory of said transmitting part;

making a call by dialing a predetermined telephone number of said receiving part when said document is completely scanned and stored in said memory;

receiving a data output order by said transmitting part from said receiving part (receiving reply from a receiver side facsimile); and

transmitting said data of said document stored in said memory according to said received data output order (last six lines).

It is well known to one of ordinary skill in the facsimile art that any conventional facsimile machine has a scanner for scanning facsimile document, a memory for either temporarily or permanently storing the scanned document and a dialing means for dialing a receiving facsimile for making a communication path.

However, Suzuki does not teach expressly the method, comprising steps of:

checking whether said call between said transmitting part and said receiving part is connected;

requiring a data output order by said transmitting part from said receiving part when said call is connected; and

displaying said data output order received from said receiving part on a display on an operational panel.

Konno, on the other hand, teaches a method, comprising steps of:

scanning a document into data to be transmitted from a facsimile of a receiving part (col. 11, lines 49-51);

storing said data of said document in a memory of said transmitting part;

making a call by dialing a predetermined telephone number of said receiving part when said document completely is scanned and stored in said memory (phase A in fig. 8);

checking whether said call between said transmitting part and said receiving part is connected (phases A & B in fig. 8);

requiring and receiving capabilities of the receiving part by the transmitting part (phase B in fig. 8);

transmitting said stored document data according to the capabilities that the receiving part can receive (col. 11, lines 57-63); and

displaying operation procedures on a display (col. 10, lines 57-59).

Suzuki and Konno are analogous art because they are from the same field of endeavor that is the facsimile art.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the facsimile protocol method shown in fig. 8 of Konno into the output order arranging method of Suzuki.

The suggestion/motivation for doing so would have been to fully recognize the capabilities of the receiving part before the transmission of the facsimile data so that the transmitting part can make necessary changes to the facsimile data.

Moreover, it would have been obvious to ordinary skill in the art at the time of the invention to implement the display panel of Konno into the facsimile of Suzuki. The motivation/suggestion for doing so would have been to inform the user with transmitting procedures when the transmitting output order (operation procedures) has been changed according to the reply received from the receiver side (last six lines of Suzuki).

Therefore, it would have been obvious to combine Suzuki with Konno to obtain the invention as specified in claim 8.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Suzuki and Konno as applied to claim 1 above, and further in view of Ogura.

11. With respect to claim 7, the combination of Suzuki and Konno teaches the method of claim 1, but it does not teach expressly that the dialing a predetermined telephone number of said receiving part is automatic.

Ogura, on the other hand, discloses a facsimile machine, wherein dialing a number of receiving facsimile is set to be automatic (col. 12, lines 45-59).

Suzuki, Konno and Ogura are analogous art because they are from the same field of endeavor that is the facsimile art.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the automatic dialing facsimile system into the facsimile system of Suzuki and Konno.

The motivation/suggestion for doing so would been to provide a system that automatically dial the receiving side when the document is completely stored in the memory. And it would have further eliminated an unnecessary step of waiting for the document to be scanned and stored.

Therefore, it would have been obvious to combine Suzuki with Konno to obtain the invention as specified in claim 7.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Suzuki and Konno as applied to claim 8 above, and further in view of Ogura.

12. With respect to claim 9, arguments analogous to those presented for claim 7, are applicable.

13. With respect to claim 10, arguments analogous to those presented for claim 3, are applicable.

14. With respect to claim 11, arguments analogous to those presented for claim 4, are applicable.

15. With respect to claim 12, arguments analogous to those presented for claim 5, are applicable.

Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Konno and in further in view of Bloomfield.

16. With respect to claim 13, Suzuki discloses an apparatus, comprising:
a scanner of a transmitting part facsimile scanning data of a document and converting the data into digital image data;

a control unit utilizing the digital image data from said scanner, said control unit controlling the transmitting part facsimile according to a system program, said control unit receiving a document output order from a receiving part facsimile, said document output order being an order of document pages determined by and being printed on said receiving part facsimile (receiving reply from a receiver side facsimile); and

a memory storing said system program guiding said control unit, the digital image data from the document being stored in said memory before being transmitted to said receiving part facsimile by a transmission signal from said controller (last six lines).

It is well known to one of ordinary skill in the facsimile art that any conventional facsimile machine has a scanner for scanning facsimile document, a memory for either temporarily or permanently storing the scanned document and a dialing means for dialing a receiving facsimile for making a communication path. Furthermore, it is well known in the art the facsimile communication is conventionally done over the telephone network using a modem.

Suzuki, however, does not disclose expressly a control unit that sends a signal requiring a document output order and an operation panel having a plurality of keys generating key data of said transmitting part facsimile to said control unit, said operational panel having a display unit showing the document output order of said receiving part facsimile.

Konno discloses a facsimile system having control unit that sends a signal requiring capabilities of receiving side and an operation panel having a plurality of keys generating key data of said transmitting part facsimile to said control unit (col. 10, lines 59-67), said operational panel having a display unit showing operational procedures (col. 10, lines 55-59). Additionally, Konno discloses a modem through a control of said control unit modulating said digital image data into analog data formatted for transmission over a public telephone network (col. 9, line 45 – col. 10, line 25) and NCU for forming a communication loop (col. 9, line 45 – col. 10, line 25).

Suzuki and Konno are analogous art because they are from the same field of endeavor that is the facsimile art.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the facsimile protocol method shown in fig. 8 of Konno into the output order arranging method of Suzuki.

The suggestion/motivation for doing so would have been to fully recognize the capabilities of the receiving part before the transmission of the facsimile data so that the transmitting part can make necessary changes to the facsimile data.

Moreover, it would have been obvious to ordinary skill in the art at the time of the invention to implement the display panel of Konno into the facsimile of Suzuki. The motivation/suggestion for doing so would have been to inform the user with transmitting procedures when the transmitting output order (operation procedures) has been changed according to the reply received from the receiver side (last six lines of Suzuki).

However, both Suzuki and Konno do not disclose expressly that the network control unit forms a communication loop of the public telephone network having a ring and a tip.

Bloomfield discloses a facsimile communication system using a communication loop of the public telephone network having a ring and a tip capabilities (col. 4, lines 26-36).

Suzuki, Konno and Bloomfield are analogous art because they are from the same field of endeavor that is the facsimile art.

Art Unit: 2622

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the PTSN having a ring and a tip signal into the facsimile system of Suzuki and Konno to provide a facsimile network having a ring and a tip capabilities.

Therefore, it would have been obvious to combine Suzuki, Konno and Bloomfield to obtain the invention as specified in claim 13.

17. With respect to claim 14, arguments analogous to those presented for claim 3, are applicable.

18. With respect to claim 15, arguments analogous to those presented for claim 4, are applicable.

19. With respect to claim 16, arguments analogous to those presented for claim 5, are applicable.

20. With respect to claim 17, arguments analogous to those presented for claim 6, are applicable.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
August 23, 2004

Chan S. Park
Examiner
Art Unit 2622


EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600